THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte SANG-SU LEE

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Appeal No. 95-4256
Application 08/127,519[1]

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HEARD: November 3, 1998

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Before URYNOWICZ, THOMAS, and FLEMING, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-5, all the claims pending in the application.

The invention pertains to a method of operating a microprocessor-controlled

[1] Application for patent filed September 28, 1993.

television. Claim 1 is illustrative and reads as follows:

1. A method for automatically turning on a set turned off due to noise, said method comprising the steps of:

(a) determining if a set is turned off due to noise;

(b) storing first data representative of a prior-to-turn-off state, when the set is turned off due to noise; and

(c) comparing said first data with second data representing a turned-off state if noise is removed to produce a compared result, and if the compared result is the same, automatically turning on the set, while if the compared result is not the same, initializing said first data, and then awaiting a key manipulation.

The references relied upon by the examiner as evidence of obviousness are:

Testin et al. (Testin)	4,641,190	Feb. 3, 1987
Hakamada	4,750,040	Jun. 7, 1988

The appealed claims stand rejected as unpatentable over Hakamada and Testin under 35 U.S.C. § 103.

The respective positions of the examiner and the appellant with regard to the propriety of these rejections are set forth in the final rejection (Paper No. 8) and the examiner's answer (Paper No. 15) and the appellant's brief (Paper No. 14) and reply brief (Paper No. 16).

Appellant's Invention

Appellant discloses a method for automatically turning on a television set which was turned off due to power line noise. First, it is determined when the set is turned off due to

noise. Next, data representing a prior-to-turn-off state of the set is stored, and a comparison is made of this data with data representing a turned-off state when noise is removed. If the data are the same, the set is automatically turned on. If the data are different, the set is re-initialized by placing it back into the original operative condition using the first data (the data representing a prior-to-turn-off state). That is, the data representing the turned-off state is corrected using the data representing the prior-to-turn-off state. The set is then turned on manually.

The Rejection under 35 U.S.C. §103

After consideration of the positions and arguments presented by both the examiner and the appellant, we have concluded that the rejection should not be sustained.

The examiner bears the burden of establishing a prima facie case of obviousness. That burden has not been satisfied because there is no showing by the examiner of some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would have led that individual to combine the relevant teachings of the references. In re Fritch, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). It appears from the answer, that the examiner has just assumed that the teachings of Hakamada and Testin are combinable.

With respect to claims 1-4, the examiner acknowledges that Hakamada fails to disclose 1) a TV set that is turned off due to noise, 2) the step of determining if the set is turned off due to noise, 3) the step of comparing data representing two different states (a prior-to-turn-

off state and a turned-off state) and 4) automatically turning on the set when the compared data are the same. At pages 5 and 6 of the answer, the examiner in effect acknowledges that Testin also fails to disclose the subject matter of items 1-4, above. Even assuming the examiner had satisfied the burden of establishing that one of ordinary skill in the art would have found it obvious to combine the teachings of Hakamada and Testin, it has not been established that the modifications of the combined prior art suggested by the examiner would have been obvious. In re Fritch, supra. There is no evidence in support of any of the examiner's suggested modifications. Furthermore, with respect to the first acknowledged deficiency of the prior art (item 1, above), the position of the examiner to modify Testin by not simply blanking the screen, but by shutting down Testin's entire system to prevent permanent and costly damage from large voltage peaks is not well taken. Testin teaches blanking the picture screen and muting the audio output against undesired noise responses. There is no teaching in Testin, or any other evidence, that large voltage peaks occur in Testin's system during tuning of the television receiver which might suggest shutting the receiver off when changing channels. Thus, there is no teaching in Testin which would suggest turning off Hakamada's set due to noise.

There being no teaching in the prior art of turning off a receiver due to noise, it would not have been obvious to determine if a set is turned off due to noise (item 2) or to automatically turn on the set (item 4).

With respect to the comparing step acknowledged as not taught in the prior art

(item 3), the examiner's position is simply that the modification necessary to meet the claim language would have been obvious. The position is unpersuasive, because it has not been established that there was some suggestion or incentive to due so. The mere fact that the combination of Hakamada and Testin could have been modified in the manner suggested by the examiner does not make the modifications obvious unless the prior art suggested the desirability of the modification.

As to independent claim 5, the rejection is not sustained essentially for the same reasons that the rejection of claims 1-4 is not sustained. There is no showing that the teachings of Hakamata and Testin can be combined. Even assuming that such a combination were proper, it has not been established that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings so as to perform with respect to an electronic device which has been turned off due to noise, the steps of 1) determining if the electronic device has been turned off, 2) comparing first and second sum data, and 3) automatically turning on the electronic device.

REVERSED

STANLEY M. URYNOWICZ, JR.	)
Administrative Patent Judge	)
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	) BOARD OF PATENT
JAMES D. THOMAS	)
Administrative Patent Judge	) APPEALS AND
	)
	) INTERFERENCES
	)
MICHAEL R. FLEMING	)
Administrative Patent Judge	)

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